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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,482	12/08/2003	Bruce Steinberg	062365.00006	2564

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EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/730,482	<b>Applicant(s)</b> STEINBERG, BRUCE	
	<b>Examiner</b> Charles A. Marmor, II	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05112004</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed May 11, 2004 fails to fully comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. In the information disclosure statement, a cover letter is provided that includes a list of patents and publications that were cited in a parent application and indicates that copies of these references have not been provided in accordance with 37 CFR 1.98(d). However, these patents and publications are not provided on the Form PTO-1449 submitted with the cover letter. The list of patents and publications submitted on the cover letter of the information disclosure statement filed May 11, 2004 has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

2. The disclosure is objected to because of the following informalities: at page 1, in the paragraph under the heading "Cross References to Related Applications," the current status of the parent application should be provided. Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Imoto ('312).

Imoto teaches a device for evaluating a limb. The device includes an applicator instrument including a base portion (6); a housing portion (30); a force plate (12) and a force probe (5) which are slidably related to one another; a spring (17) which biases the force probe relative to the force plate; a pair of stabilizing columns (14); and an encoder (1) positioned within the instrument for measuring the relative distance between the force plate and force probe. The instrument may further include a load cell (not shown) interconnected to the force probe for use in measuring the pressure applied to the force probe.

5. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Leonard et al. ('044).

Leonard et al. teach a method for a user to evaluate a muscles of a limb which may be suspected of compartment syndrome. The method includes applying increasing pressure to the limb being evaluated over a predetermined time period with the distal end of an applicator instrument (20) including a force plate (23) and a force probe (68); monitoring the predetermined time period by way of a concluding signal that is detectable by the user; sensing and measuring the pressure applied to the force probe; storing a series of pressure measurements over the predetermined time

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period; sensing and measuring the distance between the force plate and force probe; storing a series of distance measurements over the predetermined time period; monitoring the force rate of application of the device; and modifying the rate of application of force based upon the monitoring.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Imoto ('312) in view of Moeny ('469). Imoto, as discussed above, teaches all of the limitations of the claim except that the device includes a series of lights for providing a user feedback regarding the force application of the instrument. Moeny teaches a device including a force probe (2) and a series of lights (8) that provide a user with feedback regarding the force application of the instrument. It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to provide a device similar to that of Imoto with a series of lights similar to those of Moeny in order to provide a user with feedback regarding the force application of the instrument.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1 and 3-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,659,967. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent and the claims of the instant application are directed to substantially equivalent inventions or obvious variations thereof.

Regarding claim 1 of the instant application, the claim is merely broader than claim 1 of the patent. Both claim 1 of the patent and claim 1 of the instant application recite an applicator instrument including a base portion; a force plate; a force probe that is slidably positioned through an aperture in the force plate, where the force plate and the force probe are biased relative to one another; at least one stabilizing column slidably received in the base portion; an encoder; and a load cell. The cross section of the probe has an area that inherently is smaller than the cross sectional area of the force plate, since the force probe must be inserted through an aperture in the force plate. Claim 1 of the patent recites additional elements not recited in claim 1 of the instant application. Since claim 1 of the patent "anticipates" the broader claim 1 of the instant application, the claims are not patentably distinct.

Regarding claim 3 of the instant application, the claim is merely broader than claims 1

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and 2 of the patent. Claims 1 and 2 of the patent and claim 3 of the instant application all recite an applicator instrument including a force plate; a force probe that is slidably positioned through an aperture in the force plate; a spring that biases the force probe relative to the force plate; an encoder; and a load cell. The cross section of the probe has an area that inherently is smaller than the cross sectional area of the force plate, since the force probe must be inserted through an aperture in the force plate. Claim 1 of the patent recites additional elements not recited in claim 3 of the instant application. Since claims 1 and 2 of the patent "anticipates" the broader claim 3 of the instant application, the claims are not patentably distinct. Claims 3 and 4 of the patent correspond to claims 4 and 5 of the instant application, respectively.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lloyd et al. ('962) teach a method and device for detecting edema. Steinberg ('435) teaches a noninvasive compartment measurement device.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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April 8, 2005